

Amendments to the Drawings

The replacement sheets of drawings, attached following page 7 of this paper, include changes to FIGS. 14, 16, 17, 18 and 20 and replace the original sheets including FIGS. 14, 16, 17, 18 and 20. In FIG. 14, the “washer” element previously labeled “533” was relabeled with the element numeral “534” and the “screw” element previously labeled “528” was relabeled with the element numeral “536”. In FIG. 16, the element previously labeled “223” was relabeled with the correct element numeral “233”. In FIG. 17, previously omitted element numeral “320” has been added. In FIG. 18, the element previously labeled “514” was relabeled with the element numeral “235”. In FIG. 20, previously omitted element numerals “320”, “390”, and “514” have been added.

Attachments following page 15 of the paper: Five (5) Replacement Sheets

Remarks

The Office Action rejected claims 1, 2, 4, 6-9, 11-21, 23-27 and 29. These claims are respectfully presented herein for reexamination and reconsideration, which is respectfully requested.

The Office Action pointed to specific informalities in the labeling of elements in the drawings. As indicated above under the subheading "Amendments to the Drawings" and as set forth in the Replacement Sheets and Annotated Sheets following page 7 of this paper, Applicants have proposed amendments to the drawings to address those informalities. Accordingly, Applicants believe the drawings to be in proper form and request approval of the proposed changes and withdrawal of the objections to the drawings.

The Office Action indicates that claims 14-21, 23-27 and 29 would be allowable if the rejections under 35 U.S.C. 112, 1st paragraph, were overcome. In particular, the Examiner objects to the specification as being unclear and contends that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains to make and/or use the invention. Applicants have amended various paragraphs of the specification of the application to overcome any informalities. In particular, for example, the Applicants have labeled the yoke element in FIGS. 17 and 20, and have amended the specification at paragraphs 59 and 60 to clarify the illustrated interrelationship between the yoke element, the angular-adjustment lever, the fine-adjustment mechanism, and other elements of the present invention, as requested by the Examiner. The amendments introduce no new matter into the specification and are fully supported by the original specification and illustrations. Applicants believe claims 14-21, 23-27 and 29 are now in the condition the Patent Office indicated would be allowable, and accordingly, withdrawal of the rejection under 35 U.S.C. 112 is respectfully requested.

The Office Action rejected claims 1, 2, 6, and 7-13 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 2003/0200852 (hereinafter "Romo"). Applicants respectfully note that Romo does not qualify as prior art and, therefore, cannot form the basis of a 102(e) rejection, because the subject matter of claims 1, 2, 6, and 7-13 in the present application is entitled to the benefit of the filing date of Romo under 35 U.S.C. 120. It is explicitly stated in MPEP § 2137.01(VI), paragraph A, that "where [a] claimed invention in a later filed application is entitled to the benefit of an earlier filed application under 35 U.S.C. 120 (an overlap of inventors rather than an identical inventive entity is permissible) ... a rejection under 35 U.S.C. 102(e) is precluded". (emphasis added). In support of this rule, MPEP §

2137.01 cites *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279, 281 (Fed. Cir. 1988), which involves a set of facts that are almost identical to those here. In particular, the *Applied Materials* case centers around the issue of whether a patent (the '712 patent) to two inventors (McNeilly and Benzing) constituted prior art under 35 U.S.C. § 102(e) in determining the patentability of claims in a continuation-in-part application to the '712 patent (the '313 patent) to an inventorship entity consisting of the two inventors and a third person (McNeilly, Benzing and Locke). In *Applied Materials*, the Federal Circuit held that "the '712 patent is not prior art as to the '313 patent", reasoning that "the fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art". The court then stated that "even though an application and a patent have been conceived by different inventive entities, if they share one or more persons as joint inventors, the 35 U.S.C. 102(e) exclusion for a patent granted to 'another' is not necessarily satisfied". In this regard, the Federal Circuit set forth the rule in *Applied Materials* that "if the invention claimed in the '313 patent is fully disclosed in the '712 patent, this invention had to be invented before the filing date of the '712 patent and the latter cannot be 102(e) prior art to the '313 patent". (emphasis added).

In the present case, as was acknowledged by the Examiner at page 6 of the present Office Action, the pending application is a "continuation-in-part" of Romo. Accordingly, by definition, the present application has the benefit of the earlier filing date of Romo for that subject matter within the present application which is disclosed in Romo. In this regard, it is explicitly acknowledged by the Examiner at pages 6-7 of the present Office Action that the subject matter of pending claims 1, 2, 6, and 7-13 is disclosed in Romo, as the Examiner states that "Romo discloses the same invention" (last paragraph of page 6 and at the first full paragraph of page 7) (emphasis added). Accordingly, the subject matter of pending claims 1, 2, 6, and 7-13 was fully disclosed within Romo and that these claims are entitled to the filing date of Romo. Under the exception provided in MPEP § 2137.01(VI), paragraph A, and the rule of *Applied Materials*, Romo is precluded as 102(e) prior art to pending claims 1, 2, 6, and 7-12, and therefore the anticipation rejection is rendered moot, and withdrawal of the rejection is respectfully requested.

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

In re Appln. of Romo et al.
Application No. 10/702,332
Response to Office Action of May 18, 2005

Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



Thomas A. Belush, Reg. No. 37,090
GARDNER CARTON & DOUGLAS LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: August 18, 2005

In re Appln. of Romo et al.
Application No. 10/702,332
Response to Office Action of May 18, 2005

CERTIFICATE OF MAILING

O I P E J E T S
AUG 22 2005
PATENT & TRADEMARK OFFICE
I hereby certify that this RESPONSE TO OFFICE ACTION OF MAY 18, 2005
(along with any documents referred to as being attached or enclosed) is being deposited with
the United States Postal Service on the date shown below with sufficient postage as first class
mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O.
Box 1450, Alexandria, Virginia 22313-1450.

Date: August 18, 2005

I. Mikitiouk
Irina L. Mikitiouk

DC01/ 488800.1